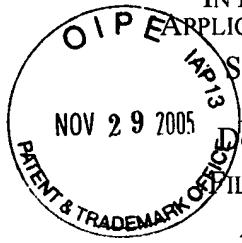


Application Serial No.: 09/893,460
Attorney Docket No. 089070-0311366 (23449-013)
In Response to the Final Office Action mailed October 11, 2005

Customer No.: 00909

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



IN RE PATENT Joseph G. GATTO
APPLICATION OF:
SERIAL No.: 09/893,460
ATTORNEY 089070-0311366 (23449-013)
DOCKET NO:
FILING DATE: June 29, 2001
ART UNIT : 3624
EXAMINER NARAYANSWAMY SUBRAMANIAN
FOR: SECURITY ANALYST ESTIMATES PERFORMANCE VIEWING SYSTEM AND
METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

In response to the Final Office Action mailed **October 11, 2005** (hereinafter "Final Action"), Applicant requests a review of the Final Rejection in the above-referenced application. This request is being filed concurrently with a Notice of Appeal.

The review is requested for the reasons set forth in the **Remarks** beginning on page 2 of this paper.

A total of 5 pages are provided.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and are hereby authorized to be charged to our Deposit Account No. 033975 (**Ref. No. 089070-0311366**).

REMARKS

Review is requested for: (1) the rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting; (2) the rejection of claim 40 under 35 U.S.C. §101; and (3) the rejection of claims 1-3 and 6-40 under 35 U.S.C. §103(a). Claims 1-40 are pending in this application and currently stand rejected. Claims 4 and 5 are indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. *See* Final Action, pg. 4, ¶8. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

NON-STATUTORY DOUBLE PATENTING REJECTION

Review is requested for the rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claim 43 of U.S. Patent Application No. 10/119,082 to Gatto (hereinafter “Gatto ‘082). *See* Final Action, pg. 3, ¶5.

In particular, the Examiner alleges that all of the features of independent claim 1 of the above-referenced application are listed in claim 43 of Gatto ‘082, with the exception of “*means for issuing an alert when at least one predetermined alert condition has been satisfied.*” The Examiner alleges that this feature would have been obvious to one of ordinary skill in the art, however, because the “*issuance of alert would have allowed the user to take appropriate action in response to the alert.*” This rejection is improper and should be withdrawn.

Claim 1 of the above-referenced application includes the feature of “*means for analyzing the current estimate data and determining when one or more alert conditions are satisfied.*” The Examiner alleges that this feature is present in claim 43 of Gatto ‘082. Specifically, the Examiner alleges that the “*at least one error metric*” as recited in claim 43 is an alert condition. *See* Final Action, pg. 4. This is incorrect.

Claim 43 of Gatto ‘082 is directed to a computer-implemented system for objectively measuring security analysts’ performance based on historical accuracy of their earnings predictions for one or more securities. The claim recites a user interface for selecting criteria, and a processor for determining performance based on the selected criteria and historical data.

One example of the criteria that may be selected includes at least one error metric to be used to calculate performance. As such, in claim 43 of Gatto '082, error metrics are not alert conditions relating to current estimate data for a plurality of analysts.

In the Final Action, at pg. 5, ¶9, the Examiner alleges that support for his interpretation may be found in claims 6, 7, and 10 of the instant application. Applicant disagrees. Error metrics (as disclosed and claimed in Gatto '082) may comprise various metrics used when objectively measuring security analysts' performance based on historical accuracy of their earnings predictions for one or more securities. By contrast, the alert conditions as disclosed and claimed in the instant application relate to current estimate data for analysts. Applicant maintains the traversal of this rejection for *at least* the reason that the rejection appears to be predicated on a misinterpretation of the term "error metric" as it used in claim 43 of Gatto '082.

Moreover, the Examiner's recited motivation for modifying Gatto '082, as quoted above, is legally improper for *at least* the reason that it only states what a benefit of the modification would be, but fails to demonstrate any teaching, suggestion, or motivation found in either Gatto '082, or in the knowledge generally available to one of ordinary skill in the art, as to why it would have been obvious to modify Gatto '082. For *at least* each of the foregoing reasons, this rejection is improper and should be withdrawn.

REJECTION UNDER 35 U.S.C. §101

Review is requested for the rejection of claim 40 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. *See* Final Action, pg. 2, ¶3. In particular, the Examiner alleges that the aforementioned claim does not "*claim a technological basis.*" This rejection should be withdrawn for *at least* the reason that the Examiner is improperly reading limitations into 35 U.S.C. §101 on the subject matter that may be patented. The Board of Patent Appeals and Interferences has held that "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." *Ex Parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005). As such, the Examiner's focus on whether the claim involves a technological basis is not relevant. Accordingly, the rejection of claim 40 under 35 U.S.C. §101 is legally improper and should be withdrawn.

REJECTIONS UNDER 35 U.S.C. §103

Review is requested for the rejection of claims 1-3 and 6-40 under 35 U.S.C. §103(a) over U.S. Patent No. 5,608,620 to Lundgren in view of U.S. Patent No. 6,208,720 to Curtis *et al.* (“Curtis”). See Final Action, pg. 4, ¶7. The Examiner has maintained the rejections previously set forth in the First Office Action mailed March 25, 2005 (hereinafter “First Office Action”) at pg. 4, ¶7. This rejection should be withdrawn for *at least* the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

A. Independent Claims 1 and 40.

In the First Office Action, at pg. 5, the Examiner recites that Lundgren does not explicitly teach the features (in independent claims 1 and 40) of determining when one or more alert conditions are satisfied, and issuing an alert when at least one predetermined alert condition is satisfied for at least one analyst, as disclosed and claimed by Applicant. The Examiner relies on Curtis for these features, however, alleging that the “*combination of the disclosures taken as a whole suggests that users would have benefited from being informed about abnormal conditions so as to take appropriate actions in response to the notification of abnormal conditions.*”

In the Response filed on June 27, 2005, Applicant argues that the Examiner’s recited motivation merely states what the alleged combination of the disclosures would suggest, or what “benefit” the combination of the disclosures may provide. In other words, the Examiner has focused on the “result” of the combination of Lundgren and Curtis, but has not provided a legally proper teaching, suggestion, or motivation to combine the two references. This is legally improper. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d (BNA) 1596, 1598-99 (Fed. Cir. 1988).

In the Final Action, at pg. 5, the Examiner responds to this argument by reciting: “*In this case, the motivation to combine is the benefit that users would have received from combining the teachings. This motivation would have been obvious to one of ordinary skill in the art.*” This is clearly legally improper. Having provided no motivation to combine or modify the references, other than to state what a benefit of the combination may be, it appears as though the Examiner

has engaged in hindsight reconstruction to pick and choose among separate disclosures to allegedly arrive at Applicant's claimed invention. For *at least* this reason, the Examiner has failed to establish a *prima facie* case of obviousness and, accordingly, the rejection of claims 1 and 40 is improper and should be withdrawn.

B. Dependent claims 2-3, and 6-39.

Dependent claims 2-3 and 6-39 are allowable because they depend from allowable independent claim 1, as well as for the further limitations they contain. Applicant traverses the Examiner's unsupported contention (*see* First Office Action, pg. 5) that the features of claims 2-3, and 6-39 are old and well known in the art. The Examiner alleges that it would have been obvious to include the features of claims 2-3, and 6-39 with the combined disclosures of Lundgren and Curtis because the "*combination of the disclosures taken as a whole suggests that users would have benefited from being informed about abnormal conditions so as to take appropriate actions in response to the notification of abnormal conditions.*"

Aside from providing a legally improper motivation identical to that alleged in the rejection of claims 1 and 40 (as discussed above), the Examiner has provided no evidence to support the contention that the features of any of claims 2-3 and 6-39 are old and well known in the context of a system for monitoring analysts' estimates, as disclosed and claimed by Applicant. Accordingly, having provided no evidentiary support for the rejection of any of dependent claims 2-3 and 6-39, the Examiner's rejection of these claims is improper and should be withdrawn.

Date: November 29, 2005

Respectfully submitted,

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